



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket 16274US01)

In the Application of:

Rebecca S. Busch

Serial No.: 09/713,619

Filed: 11/15/2000

For: A SYSTEM AND A METHOD FOR
AN AUDIT AND VIRTUAL CASE
MANAGEMENT OF A BUSINESS
AND/OR ITS COMPONENTS

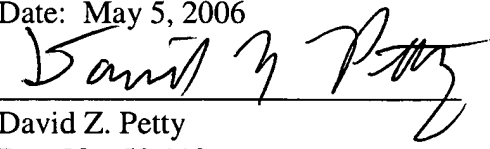
Examiner: Carolyn M. Bleck

Group Art Unit: 3626

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) Date: May 5, 2006

) 
) David Z. Petty

) Reg. No. 52,119

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

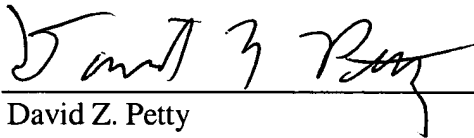
This request is being filed with a petition for 1 (one) month extension of time and a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: May, 5, 2006

By:



David Z. Petty

Reg. No. 52,119

Attorney for Applicant

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REMARKS

The present application includes pending claims 1-34. Claims 4-12 and 17-34 have been elected with traverse. Claims 1-3 and 13-16 have been canceled. Claims 4-12 and 17-34 have been rejected. Claims 11, 12, and 26-34 remain rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 9-10 and 22-25 remain rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 4, 11, 18, 26-27, and 29 remain rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,643,625 to Acosta. Claims 5 and 8 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Acosta as applied to claim 4. Claims 7, 17, 19, and 20 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Acosta as applied to claim 4 and further in view of U.S. Pat. No. 6,529,876 to Dart. Claims 9-10, 12, 22-25, and 31-34 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Acosta in view of Dart. Claims 21, 28, and 30 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Acosta as applied to claims 4, 11, and 12, and further in view of U.S. Pat. No. 6,826,536 to Forman.

I. Claims 11-12, 26-30, and 31-34 Are Patentable Under 35 U.S.C. § 101

The Applicant respectfully submits that claims 11-12, 26-30, and 31-34 are not directed to non-statutory subject matter. *See* March 3, 2006 Reply at pp. 2-7.

First, the Examiner previously acknowledged that the inventions of claims 11 and 12 (and their dependent claims 26-30 and 31-34, respectively) do indeed produce useful, concrete and tangible results. *See* July 29, 2005 Office Action at p. 5.

Second, claims 11 and 26-30 produce a specific, substantial, and real-world result that can be used as part of a general audit to correct errors and modify procedures by reciting a system that produces a test audit of a pilot area and mine-able errors. *See* March 3, 2006 Reply at pp. 4-5.

Third, claims 12 and 31-34 produce a specific, substantial, and real-world result that can be used as part of a system of virtual case management of a business by reciting a system that provides for a flow chart used to create a case management tool to manage a business. *See id.* at pp. 5-6.

Fourth, the Examiner asserts that the inventions of claims 11 and 12 do not qualify as patentable subject matter because the inventions of claims 11 and 12 fail to transform an article to a different state or thing. However, under *Ex Parte Lundgren*, the only test for patentability

under § 101 is whether the claimed invention produces a useful, concrete, tangible, result. *See id.* at p. 6.

Finally, even assuming the “transformation” test is appropriate for determining patentability under § 101, claims 11, 12, and 26-34 are still patentable under such a test. In claim 11, a specification code is transformed for use in an auditing chart and errors from an audit are transformed by being stored and mined in a database. In claim 12, errors from a continuous audit are transformed by being stored and mined in a database, and the errors mined from the database are transformed to create a flowchart and a case management tool. *See id.* at pp. 6-7.

II. Claims 9-10 and 22-25 Are Patentable Under 35 U.S.C. § 112

The Applicant respectfully submits that claims 9-10 and 22-25 satisfy § 112. *See id.* at pp. 7-11.

First, the phrase “a process including different fields” from claim 9 is not indefinite or unclear in light of reading claim 9 in its entirety and a previous amendment of claim 9. *See id.* at p. 7.

Second, a person of skill in the art would understand how to use errors from data mining to create flowcharts for the fields of the process as recited in claim 9 based on the specification and the ordinary meaning of the term “flow chart.” *See id.* at pp. 8-9.

Third, the case management tool is not a form of flowchart. The flowcharts and the case management tool recited in claim 9 are distinct and different features and the flowcharts and case management tool are used differently. *See id.* at p. 9.

Finally, the limitation of “mitigating the errors in the process by using the case management tool to manage and direct resources for the process to avoid or limit new errors in the process” recited in claim 9 is clear when viewed in the context of the entire claim 9. A person of skill in the art would know how to use the information in the case management tool related to previous errors found in the process to manage and direct resources for the process to avoid or limit new errors in the process and thus mitigate errors in the process. *See id.* at p. 10.

III. Acosta Does Not Teach, Nor Suggest, All the Limitations of Claims 4, 11, 18, 26-27, and 29

The Applicant respectfully submits that Acosta does not teach, nor suggest, all the limitations of Claims 4, 11, 18, 26-27, and 29.

First, Acosta does not teach, nor suggest any of the limitations of “conducting a general audit of the business,” “establishing a specification code for each function of the business,” “using the specification code to create an auditing chart,” “choosing a pilot area associated with the area in which the significant error occurs to test the auditing chart,” “auditing the pilot area with the auditing chart at the location of the transaction,” “collecting information during the auditing of the pilot area,” “modifying the auditing of the business on-site based on the information collected in the pilot area,” “updating the specification code,” or “auditing the pilot area with the updated specification code and the auditing chart” as recited in claim 4, or claim 18, which depends from claim 4. *See id.* at pp. 11-16.

Second, Acosta does not teach, nor suggest any of the limitations of “a function [of the business] being assigned a specification code,” “an auditing chart created with the specification code,” or “a pilot area of the facility of the business to test the auditing chart” as recited in claim 11, or claims 26, 27, and 29 which depend from claim 11. *See id.* at pp. 16-17.

Third, Acosta does not teach, nor suggest, “an updated specification code is assigned to the function performed within the facility of the business” as recited in claim 26. *See id.* at p. 17.

IV. Claims 5 and 8 Are Not Obvious Over Acosta as Applied to Claim 4

Acosta does not anticipate claim 4 and therefore claims 5 and 8 are not obvious over Acosta as applied to claim 4 and, with respect to claim 5, Acosta does not teach, nor suggest, “auditing on a day-to-day basis.” *See id.* at pp. 18-19.

V. Claims 7, 17, 19, and 20 Are Not Obvious Over Acosta as Applied to Claim 4 in View of Dart

The combination of Acosta and Dart does not teach, nor suggest all the limitations of claim 4, and therefore claims 7, and 17, 19, and 20, which depend from claim 4, are not obvious over Acosta in view of Dart, and there is no such motivation or suggestion to combine Acosta with Dart to arrive at the inventions of claims 7, 17, 19, and 20. *See id.* at pp. 19-23.

VI. Claims 9-10, 12, 22-25, and 31-34 Are Not Obvious Over Acosta in View of Dart

The combination of Acosta and Dart does not teach all the limitations of claims 9, 10, and 22-25, and thus claims 9, 10, and 22-25 are not obvious over Acosta in view of Dart, and there is no motivation to combine Acosta with Dart to arrive at the inventions of claims 9, 10, and 22-25. *See id.* at pp. 23-26.

The combination of Acosta and Dart does not teach all the limitations of claims 12 and 31-34, and thus claims 12 and 31-34 are not obvious over Acosta in view of Dart, and there is no motivation to combine Acosta with Dart to arrive at the inventions of claims 12 and 31-34. *See id.* at pp. 26-28.

VII. Claims 21, 28, and 30 Are Not Obvious Over Acosta as Applied to Claims 4, 11, and 12 in View of Forman

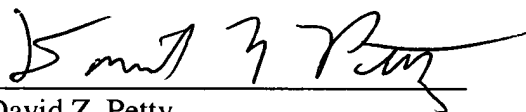
The combination of Acosta and Forman does not teach, nor suggest all the limitations of claims 21, 28, and 30, and there is no motivation to combine Acosta with Forman to arrive at the inventions of claims 21, 28, and 30. *See id.* at pp. 28-32.

VIII. Conclusion

The Applicant respectfully submits that the pending claims of the present application should be in condition for allowance at least for the reasons discussed above and requests reconsideration of the claim rejections. The Commissioner is authorized to charge any necessary fees, including the \$250 fee (small entity) for the Notice of Appeal and the \$60 fee for a one month extension of time, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: May 5, 2006


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